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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,119	04/13/2007	Timothy Charles Ramsey Prickett	36697.17	1813
27683 7590 07/06/2010 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
			EXAMINER GRUN, JAMES LESLIE	
			ART UNIT 1641	PAPER NUMBER
			MAIL DATE 07/06/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,119

Applicant(s)

PRICKETT ET AL.

Examiner

JAMES L. GRUN

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-14, 16-20, 23-32, 44, 46-48, 50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 9-12, 14, 16-20 and 29-32 is/are allowed.
- 6) ☒ Claim(s) 13, 23-28, 44, 46-48, 50 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The amendment filed 22 April 2010 is acknowledged and has been entered. Claims 8, 15, 21, 22, 33-43, 45, and 49 have been cancelled. Claims 1-7, 9-14, 16-20, 23-32, 44, 46-48, 50, and 51 remain in the case.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 23-28, 44, 46-48, 50, and 51 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, the interrelationships of the steps of the method are not clear because it is not clear if additional antibodies and fragments are being claimed or if the previously recited antibodies can be intact antibodies or NT-CNP-binding antibody fragments and are immobilized.

In claims 23, 24, 46, 50 and claims dependent thereupon, recitations of “said . . . fragment” lack antecedent basis.

In claim 26, the interrelationships of the steps of the method are not clear because it is not clear if additional antibodies and fragments are being claimed or if the previously recited antibodies can be intact antibodies or NT-CNP-binding antibody fragments and are immobilized.

In claim 27, the interrelationships of the steps of the method are not clear because it is not clear how diagnosis of diseases or disorders relate to assessing skeletal growth potential/cessation as claimed in claim 14.

In claim 28, the interrelationships of the steps of the method are not clear because “said skeletal disease or disorder” lacks antecedent basis in claim 14.

Claim 44 is unduly duplicative of the subject matter as claimed in claim 3.

Claims 48, 50, and 51 are unduly duplicative of the subject matter as claimed in claims 1, 9, and 11.

Applicant's arguments filed 22 April 2010 have been fully considered but they are not deemed to be persuasive. Notwithstanding applicant's assertions to the contrary, disease diagnosis is not the assessment being made in claim 14. Moreover, although claims are interpreted in light of the disclosure, limitations from the specification are not imported into the claims unnecessarily. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."). Notwithstanding applicant's assertions to the contrary, applicant's amendments have not obviated rejections under this statute for the reasons set forth above.

Claims 1-7, 9-12, 14, 16-20, and 29-32 are currently free of the prior art of record and are in allowable form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Grun, Ph.D., whose telephone number is (571) 272-0821. The examiner can normally be reached on weekdays from 11 a.m. to 7 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya, SPE, can be contacted at (571) 272-0806.

The phone number for official facsimile transmitted communications to TC 1600, Group 1640, is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application, or requests to supply missing elements from Office communications, should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. L. G./
James L. Grun, Ph.D.
Examiner, Art Unit 1641
July 6, 2010

/Mark L. Shibuya/
Supervisory Patent Examiner, Art Unit 1641